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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10 030,306	06/27/2002	Seishi Kato	GIN-6730CPUS	8889

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FITZPATRICK, CELLA, HARPER & SCINTO
30 Rockefeller Plaza
New York, NY 10112-3801

EXAMINER

LIU, SAMUEL W

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 06/03/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,306

Examiner

Samuel W Liu

Applicant(s)

KATO ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicants' election of Group I, claims 2-6 in Paper No.8 filed 28 March 2003 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). During a telephone conversation with Lawrence Perry April 14, 2003, provisional additional election for polynucleotides (SEQ ID NOs: 14 and 24) was made to prosecute the elected Group I, claims 2-6. Affirmation of this election must be made by applicants in replying to this Office action. Claims 1 and 7 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Therefore, elected claims 2-6 are under examination to the extent that they are drawn to the elected invention.

Foreign Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d) based on an application (PCT/Japan 00/03942) filed in Japan on June 16, 2000. The certified copy of the PCT/Japan 00/03942 has been received.

Specification/Claim Objections

The disclosure is objected to because of the following informalities:

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

In page 6, line 5, "SEQ ID NOS:" should be changed to "SEQ ID NOs:", the same change should be made throughout the specification.

In page 9, line 18, "DEAE" should be spelled out in full for the first instance of use. See also page 22, line 3, "HIV"; page 28, line 10, "MHC"; page 32, line 16, "CSF"; page 29, line 7, "SDS"; and page 51, line 18, "ORF".

In page 20, line 1, after "Vol" should add a period "." to indicate "volume"; the same change should be made throughout the specification.

In claims 3 and 4, "SEQ ID NOS:" should be changed to "SEQ ID NOs:".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 is dependent from a non-elected claim, *i.e.*, claim 1, which renders claim 2 indefinite. The dependent claims are also rejected.

Claim 3 is not apparent as to the phrase "a base sequence"; to what does a base refers? In view of the specification does not define the recited phrase, the recitation is indefinite. The dependent claims are also rejected.

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Claims 5 and 6 recite the limitation "the DNA according to any one of claim 2 to claim 4". There is insufficient antecedent basis for this limitation in the claims 3 and 4 since the claims do not recite "the DNA".

Also, claim 5 is indefinite in the recitation "is capable of" since it does not equate to indication that the specific binding must actually occur (see "... these genes are introduced to express theses protein" at page 66 of the specification instead). See also claim 6. Further, claim 5 is unclear as to "...expressingby in vitro translation or in eukaryotic cells" wherein the recitation "*in eukaryotic cells*" per se does not refer to any biological process for gene expression to set forth a limitation to "expressing" thereof; thus, the claim is vague.

Claim 6 is indefinite for depending from the non-elected invention, *i.e.*, claim 1.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Wei Liu whose telephone number is (703) 306-3483. The examiner can normally be reached from 9:00 a.m. to 5:00 p.m. on weekdays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Christopher Low, can be reached on 703 308-2923. The fax phone number for the organization where this application or proceeding is assigned is 703 308-4242 or 703 872-9306 (official) or 703 872-9307 (after final). Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 305-4700.

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Samuel Wei Liu, Ph.D.

May 14, 2003

Karen Cochrane Carlson

KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER